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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,515	06/15/2000	Judy Glenna Shannon	KINGP.55031	1096

7590 08/06/2003

GARY M. ANDERSON
FULWIDER, PATTON, LEE & UTECHT LLP
200 OCEANGATE
SUITE 1550
LONG BEACH, CA 90802

EXAMINER

SMITH, RICHARD A

ART UNIT PAPER NUMBER

2859

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/595,515

Applicant(s)

SHANNON ET AL.

Examiner

R. Alexander Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 and 35 is/are allowed.
- 6) ☒ Claim(s) 16-25 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 June 2003 has been entered.

Claim Objections

2. Claims 26 and 27 are objected to under 35 CFR §1.75(b) since claims 26 and 27 are essentially duplicate claims of claims 34 and 35, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). In this case, the slight differences is in the intended use language incorporated in the independent parent claim 16 and a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 16-18, 24 and 29 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. 4,832,648 to Theobald et al.

Theobald et al. discloses a bookmark having a flexible, elastic intermediate member (14) or ribbon A having opposed ends, a top anchor (15) having a thickness greater than the intermediate member and being in the form of a portion of a character including a head end (figure 6) secured to the first end, a bottom anchor (23) having a thickness greater than the intermediate member and being in the form of a second portion of said character (a tail) 6) secured to the second end (figure 5), said length of the intermediate member may be extended from its predetermined length (by its ability to stretch and/or by provided different sizes), said anchors inhibit removal of the bookmark (when the book is in the closed position), said intermediate member being a stretchable ribbon in the form of an elastomeric material (62-65, 28, 29), the character including animal features, the top and bottom anchors being of plush material (column 2, lines 41-59), said top and bottom anchors being three dimensional.

With respect to claim 16, the intended use of the apparatus i.e., "for use in between pages of a book having a spine and a binding" in lines 1-2, "said thickness being of a... ..its binding;" in

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lines 4-6, "for abutting the edges of the pages of the book" in lines 7 and 10. "to accommodate books of different sizes" in line 14, and "when the bookmark is... ..of the book." in lines 16-17: these intended uses have not been given any patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Theobald et al.

Theobald et al. teaches all that is claimed as discussed in the above rejections of claims 16-18, 24 and 29 except for the limitations of claims 19-21.

With respect to claims 19-21, the character including cartoon character features, human features, and humanoid features: the character's features as being cartoon, human or humanoid is only considered to be an obvious modification of a character's features because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case to improve the marketability by provide a variety of characters which will appeal to different potential customers.

7. Claims 16, 18-25, 28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane.

Bailey et al. teaches a bookmark having a flexible, elastic intermediate member or ribbon A having opposed ends. Hooks (anchors) B are attached to each of the ends.

Bailey et al. does not teach the anchors including features of a character.

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Crane teaches a bookmark having an intermediate member or ribbon with a predetermined length and width and a loop. A first abutment member in the form of a woman's head is attached to a first end of the intermediate member, and a second abutment member in the form of legs is attached to a second end of the intermediate member. When the bookmark is used with a book, the abutment members have a thickness in a direction substantially perpendicular to the length of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bailey et al. by adding the first abutment member of Crane to the top hook of Bailey et al., and adding the second abutment member of Crane to the lower hook of Bailey et al., since Crane teaches that providing a bookmark with upper and lower character portions is beneficial for increasing the aesthetic appeal of the bookmark.

With specific regard to claim 19, the depictions of Crane are considered to be "cartoon character features", since it is clear that the broad class of cartoons can include the depictions of Crane.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to additionally modify Bailey et al. by including an upper torso and limbs with the first abutment member and by including a lower torso with limbs with the second abutment member, as a choice of design, for the purpose of making a more appealing bookmark. One it is known to utilize parts of a human for the decorative effect of a bookmark, it is merely a choice of aesthetic design to include additional parts of the human body.

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With specific regard to claims 23 and 28, since the intermediate member can be coiled around the lower limbs of the proposed modified device of Bailey et al., the lower limbs are considered to be constructed to retain a coiled portion of said intermediate member therebetween.

With regard to the top and bottom anchors being "plush", such would have been obvious to one having ordinary skill in the art at the time the invention was made, since it is clear that "plush" abutments would be beneficial since they would not scratch or otherwise mar objects while the bookmark is in use.

With regard to claims 25 and 33, the hooks of Bailey et al. are constructed for releasable engagement with each other, since they can be hooked together if desired. Also, with regard to claim 33, the preamble and the functional language "may be wrapped around an individual's wrist..." are not sufficient to set forth sufficient structure to patentably distinguish the claimed invention from the prior art.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Ward et al.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the intermediate member being made from an elastomeric material.

Ward et al. teaches a bookmark with an elastomeric band A, a plurality of hooks on the band, and a line indicator on the band.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by replacing the intermediate member thereof with the

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elastic band of Ward et al., since Ward et al. teaches that an elastomeric band is suitable for bookmarks that require stretching to accommodate books of various size. This proposed modification can result in the intermediate member being round as taught by Bailey et al., or flat as taught by Ward et al.

9. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. in view of Crane as applied to claims 16, 18-25, 28, 32 and 33 above, and further in view of Cox.

Bailey et al. and Crane together teach all that is claimed, as discussed in the above rejection of claims 16, 18-25, 28, 32 and 33, except for the first and second abutments being three-dimensional.

Cox teaches a book marker with a three dimensional ornamental element thereon. The element is in the form of a human face.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Bailey et al. by making the first and second abutments three-dimensional, since Cox teaches that three dimensional ornamental elements are known for providing a desired ornamental effect.

Allowable Subject Matter

10. Claims 34 and 35 are allowed.

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11. Claims 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

13. Applicant's arguments filed 18 June 2003 have been fully considered but they are not persuasive.

The changes made by the Applicant's amendment filed on 18 June 2003 to claims 16, 30, 32 are changes with respect to the intended use, each of these intended uses does not provide sufficient patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Therefore, Bailey in view of Crane does satisfy the claimed structural limitations for the bookmark in claims 16 and 33, and Bailey and Crane in view of Cox does satisfy the claimed structural limitations for the bookmark in claim 30.

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The Applicant's argument with respect to Bailey et al. and Ward et al. not utilizing abutment members but instead uses hooks is not persuasive since these hooks in addition to hooking also clearly abut. Abut being defined as to touch at one end or side, lie adjacent. The location of abutting is not persuasive since the book with spine and pages are recited in the claims as intended use, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that Crane does not teach or suggest abutment members, that the head and feet portions appear to be the same thickness as the intermediate ribbon portion, and that there is no need or suggestion to provide abutment means on the hooks, the examiner does not find the arguments persuasive and continues to take the position that the "head" and "legs" of Crane are abutment members since they are capable of abutting against surfaces of a book and being thicker than the intermediate ribbon portion in order to abut against the surfaces of a book. However, whether or not the "head" and "legs" of Crane can be called abutment members and are thicker is essentially moot, since the abutment members of the modified device of Bailey et al. include the hooks B of Bailey which are thicker than the intermediate ribbon portion.

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With respect to adding of the head and leg portions of Crane to the hooks of Bailey et al. will not result in the claimed invention, this argument appears to amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Smith whose telephone number is (703) 305-0647. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800

RAS
July 28, 2003